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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/009,331      | 11/06/2001  | Yoichiro Sako        |                     | 3841             |

7590 06/02/2005  
Jay H Maioli  
Cooper & Dunham  
1185 Avenue of the Americas  
New York, NY 10036

EXAMINER

RHODE JR, ROBERT E

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3625

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/009,331

Applicant(s)

SAKO ET AL.

Examiner

Rob Rhode

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 May 2002 & 3 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7, 15-18 and 27-29 is/are pending in the application. 1-4/6
- 4a) Of the above claim(s) 8-14, 19-26 & 30-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 15-18 and 27-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Response to Amendment***

Applicant's preliminary amendment of 5-23-02 amended claims 1 - 2, 4 - 5, 7 - 8, 11, 13 - 14, 18, 21 - 24, 27, 30 - 33, 35, 37 - 40 and 42 - 45. In addition, applicant's amendment of 03-03-2005 in response to the Restriction selected Group I and Claim Species of 3 - 7 for examination. Of note, the original Restrictions requirement contained typographical errors and the Examiner apologies. In that regard, the Species for 20 - 23 and 24 should have read claims 19 - 23 and Species 9 - 13 and 24, should have been Species of 9 - 13 and 24 - 25.

Currently, claims 1- 7, 15 - 18 and 27 - 29 are pending.

### ***Election/Restrictions***

Applicant's election without traverse of the Election Restriction in the reply filed on 03-03-05 is acknowledged.

### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 10/009331, filed on 11/06/2001.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

**Claims 1- 5, 15 - 18 and 27 - 29 are rejected under 35 U.S.C. 102(e) as being unpatentable over Gerba (US 5,931,908).**

Regarding claim 1 and related claims 18 (Amended), Gerba teaches an information service method, comprising steps of:

synchronously transmitting program data and information associated with at least a program of the program data; receiving the program data and the associated information; reproducing the received program data and displaying the reproduced program data on a displaying device; and extracting information associated with a portion desired and selected by a viewer from the program data and the associated and selected by a viewer from the program data displayed on the displaying device from the information associated with the program (see at least Abstract, Col 1, lines 32 -38, Col 2, lines 17 – 22 and Col 5, lines 24 – 30 and 54 - 56).

Regarding claim 2 (Amended), Gerba teaches an information service and apparatus method, wherein the method is a method for buying the selected consumer commodity (Col 1, lines 36 -38 and Col 5, lines 48 – 56).

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Regarding claim 3, Gerba teaches an information service and apparatus method, wherein the selected consumer commodity is displayed on a child screen of the displaying portion (Col 5, lines 48 – 56). Please note that Gerba does not specifically disclose a child screen. However, Gerba does disclose multiple screens. In that regard, one of ordinary skill in the art would have been motivated to extend the method of Gerba with a mnemonic of a child screen and thereby enable a child screen with additional and specific information regarding a product or item.

Regarding claim 4 (Amended), Gerba teaches an information service method, wherein the selected consumer commodity and the information associated with the selected consumer commodity are switchably displayed on the child screen (Col 5, lines 48 – 56).

Regarding claim 5 (Amended), Gerba teaches an information service method as wherein the information associated with the selected consumer commodity contains at least information about a price of the selected information about a name of that consumer commodity (Col 1, lines 36 – 38). Please note that Gerba does not specifically disclose price. However, Gerba does disclose ordering a musical album. In that regard, one of ordinary skill in the art would have been motivated to extend Gerba with a price for the album. In this manner, the buyer will know that exact cost of the album being ordered.

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Regarding claim 7 and related claims 15 and 27, Gerba teaches a information service method wherein the information associated with the consumer commodity further contains information consumer commodity is bought through a network (Col 1, lines 49 - 52).

Regarding claim 16, Gerba teaches an information service method, wherein the information associated with the selected consumer commodity is data paired with bit map addresses of a display screen for the program data (Col 5, lines 62 - 63).

Regarding claim 17 and related claim 29, Gerba teaches an information service method, wherein the information associated with the selected consumer commodity-is transmitted so that the information is synchronized with a picture of the program data (Abstract).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gerba in view of Burke (US 6,304,855 B1).**

Gerba substantially discloses and teaches the applicant's invention.

While Gerba does disclose selecting and buying a product, the reference does not specifically disclose and teach an information service method, wherein the information associated with the selected consumer commodity further contains information about a store from which the selected consumer commodity can be bought.

Regarding claim 6, Burke teaches an information service method, wherein the information associated with the selected consumer commodity further contains information about a store from which the selected consumer commodity can be bought (Figure 16).

It would have been obvious to one of ordinary skill in the art to have provided the method of Gerba with the method of Burke to have enabled a method an information service method, wherein the information associated with the selected consumer commodity further contains information about a store from which the selected consumer commodity can be bought. Gerba discloses the claim language recitations of claim 1 and 18 (see at least Abstract). In turn, Burke discloses a method for an information service method; wherein the information associated with the selected consumer commodity further contains information about a store from which the selected consumer commodity can be bought (Figure 16). Thereby, one of ordinary skill in the art would

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have been motivated to extend the method of Gerba with a method for an information service method, wherein the information associated with the selected consumer commodity further contains information about a store from which the selected consumer commodity can be bought.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art is Bernard (US 5,918,213), which discloses ordering music heard on a television.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **(703) 305-8230**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **(703) 308-1344**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

**IMPORTANT** – After April 14, 2005, the telephone numbers will change for Wynn Coggins and Rob Rhode to 571.272.7159 and 571.272.6761 respectively.

Any response to this action should be mailed to:

***Commissioner for Patents***



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***P.O. Box 1450***

**Alexandria, Va. 22313-1450**

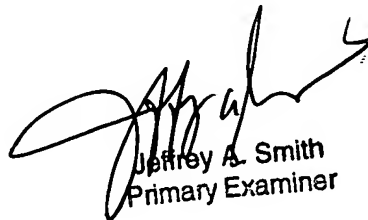
or faxed to:

**(703) 872-9306** [Official communications; including  
After Final communications labeled  
"Box AF"]

**(703) 746-7418** [Informal/Draft communications, labeled  
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal  
Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

RER



Jeffrey A. Smith  
Primary Examiner